

REMARKS

Claims 1-9 are pending in the application. In the Office Action, the Examiner rejected Claims 1-3 and 7 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,778,304 to *Grube et al.* (hereinafter *Grube*) in view of U.S. Patent No. 7,039,431 to *Mukherjee*. The Examiner rejected Claims 4-6 under 35 U.S.C. §103(a) as being unpatentable over *Grube* and *Kil*, and further in view of U.S. Publication No. 2002/0106202 to *Hunter*. The Examiner rejected Claims 8 and 9 under 35 U.S.C. §103(a) as being unpatentable over *Grube* in view of U.S. Publication No. 2003/0008662 to *Stern et al.* (hereinafter *Stern*) and *Mukherjee*. Reconsideration of this application is respectfully requested.

Regarding the rejection of Claim 1, in the Office Action at the end of page 2 the Examiner cites figs. 1-3, col. 2, lines 13-67; col. 3, line 1-col. 4, line 22 for allegedly teaching all three elements of the claim except for “when the apparatus has received the location registration request message and transmitting location registration request message and transmitting location registration response message for providing communication function.” This constitutes an improperly addressed rejection. It is incomplete and unclear. See CFR 1.104 and MPEP §707.07(d). The applicant cannot properly respond to the action because the omnibus rejection of the claim does not afford the Applicant the opportunity to ascertain the veracity of the Examiner’s interpretation of a specific element of the claim; accordingly, a new Office Action clearly and completely addressing each element of a claim should be issued. Furthermore, long passages over a few columns or pages are not a good recipe for clarity and conciseness. An interview is scheduled with the Examiner to clarify this issue among others.

Claim 1 typifies the rejection of the other claims. Therefore, rejection of the remainder of the claims should be addressed anew.

In light of the foregoing and in the spirit to respond to the Office Action, Applicant offers the following arguments.

The Examiner cites *Grube*, as a primary reference in a §103(a) rejection. In order for the Examiner to establish a prima facie case of obviousness, at least the following criterion must be met. The prior art reference (or references when combined) must teach or suggest all the claim limitations. Neither *Grube*, *Mukherjee*, *Kil*, *Stern* nor *Hunter*, nor any combination thereof, recite checking whether the additional function is available or not, when a public/private communication service apparatus receive the location registration message, and transmitting the location registration request response message including additional function restriction code if the additional function execution in the terminal is restricted, as taught by the present invention.

Grube discloses that a mobile communication terminal transmits only location coordinates periodically, while the present invention discloses transmitting a location registration request message, which corresponds to the system parameter message and indicates that a multifunctional mobile communication terminal has the additional function. Specifically, *Grube* discloses that a communication resource transmits an action message to communication units if the predefined action message corresponding to the current location of communication units is required. However, the present invention discloses checking whether the additional function is available or not, when a public/private communication service apparatus receive the location registration message, and transmitting the location registration request response message including additional function restriction code if the additional function execution in the terminal is restricted. Accordingly, *Grube* alone or in combination with the other cited references, fails to teach, disclose or fairly suggest all the claim limitations.

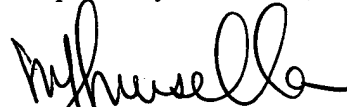
Furthermore, the Examiner asserted that *Mukherjee* discloses a location registration request message and a location registration response message. However, *Mukherjee* discloses a process of subscriber registration by internetworking MSC with HLR/VLR when the terminal enters into public mobile network, and does not disclose transmitting/receiving the location registration request message and the location registration response message between the terminal and MSC in the parts as mentioned by the Examiner. Accordingly, *Mukherjee* alone or in combination with the other cited references, fails to teach, disclose or fairly suggest all the claim limitations.

Based on at least the foregoing, withdrawal of the rejections of Claims 1 and 7-9 is respectfully requested.

Independent Claims 1, 7, 8 and 9 are believed to be in condition for allowance. Without conceding the patentability per se of dependent Claims 2-6, these are likewise believed to be allowable by virtue of their dependence on their respective amended independent claims. Accordingly, reconsideration and withdrawal of the rejections of dependent Claims 2-6 is respectfully requested.

Accordingly, all of the claims pending in the Application, namely, Claims 1-9, are believed to be in condition for allowance. Should the Examiner believe that a telephone conference or personal interview would facilitate resolution of any remaining matters, the Examiner may contact Applicant's attorney at the number given below.

Respectfully submitted,



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